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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,749	08/20/2001	William A. Royall JR.	ROY03 846	3048
39290 7590 04/15/2008 DUANE MORRIS LLP 505 9th Street Suite 1000 WASHINGTON, DC 20004-2166				
EXAMINER OUELLETTE, JONATHAN P				
ART UNIT 3629		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/931,749

Applicant(s)

ROYALL ET AL.

Examiner

Jonathan Ouellette

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-6, 9, 11, 12, 16, 20, 21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) 20, 21 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6, 9, 11, 12 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/3508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

1. Claims 3, 7, 8, 10, 13-15, 17-19, and 22 has been cancelled, and Claims 20, 21, and 23 have been withdrawn from consideration; therefore, Claims 1, 2, 4-6, 9, 11, 12, 16, 20, 21, and 23 are pending in application 09/931,749. The examination of Claims 1, 2, 4-6, 9, 11, 12, and 16 follows below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. **Claims 1 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanoff et al. (Sanoff, Alvin P.; Glasris, Kukula, The Consulting game: Schools turn to outside help to target and select students.” US News & World Report, v119, n11, p119 (4), September 18, 1995) in view of Thomas (US 2002/0002482 A1), and further in view of Bayer et al. (US 7,171,567 B1).**
4. As per **independent Claim 1**, Sanoff discloses a method for surveying candidates (pg.2, telequalifying) who may be interested in an educational institution comprising the steps of: (a) obtaining a list of candidates who are believed to have an interest in attending an educational institution; (b) developing a data base relating to the

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candidates; (c) using the information in the data base to segment the candidates into one or more candidate segments based on one or more criteria established by the educational institution (Pg.2, developing applicant pool); (e) preparing a mailing package for each candidate; (f) distributing the mailing package to each candidate (Pg.2, Direct Mailing, Target Marketing); and (g) evaluating the interest of each candidate completing a survey (Pg.2, determining extent of applicant interest).

5. Sanoff fails to expressly disclose (d) establishing an Internet based web page containing a survey form and (e) preparing an invitation for each candidate, which includes an incentive to respond to the survey and a unique user name and password for accessing the survey form by the Internet.
6. However, Thomas disclose inviting users to participate in online/Internet surveys through an e-mail invite (Para 0040, 0048) which would include survey ID and password information (Para 0065, equivalent to user name and password), and offering incentives to users to participate in the survey system (Para 0029, 0073)
7. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included (d) establishing an Internet based web page containing a survey form and (e) preparing an invitation for each candidate which includes an incentive to respond and a unique user name and password for accessing the survey form by the Internet, as disclosed by Thomas in the system disclosed by Sanoff, for the advantage of providing a method for surveying candidates who may be interested in an educational institution, with ability to increase system effectiveness and efficiency by incorporating Internet technology in the surveying process, thereby increasing the automated reach of the system to customers, while decreasing

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transmission costs (Automation of a manual process: *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)) (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

8. Furthermore, Sanoff and Thomas both fails to expressly disclose sending an invitation to participate in a survey to a user through a prepared mailing package.
9. However, Bayer discloses inviting users to participate in a survey system through e-mail, regular mail or other advertising media (C8 L30-49).
10. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included sending an invitation to participate in a survey to a user through a prepared mailing package, as disclosed by Bayer, in the system disclosed by Thomas in the system disclosed by Sanoff, for the advantage of providing a method for surveying candidates who may be interested in an educational institution, with ability to increase system effectiveness, efficiency, and ability to reach a larger population, by sending invitations to potential users through a variety of communication formats (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).
11. As per **independent Claim 16**, Sanoff discloses a method for surveying candidates who may be interested in an educational institution comprising the steps of: (a) obtaining a list of candidates who are believed to have an interest in attending an educational institution; (b) developing a data base relating to the candidates; (c) using the information in the data base to segment the candidates based on one or more

criteria established by the educational institution; (f) distributing the mailing package to each candidate; and (h) evaluating the interest of each candidate completing a survey.

12. Sanoff fails to expressly disclose (d) establishing an Internet based web page containing a survey form; (e) preparing an invitation for each candidate which includes (1) an incentive to respond to the survey, and (2) a unique user name and password for accessing the survey form by the Internet; and (g) e-mailing each candidate a unique user name and password for electronically accessing the survey form and a hyperlink to the survey form.
13. However, Thomas disclose inviting users to participate in online/Internet surveys through an e-mail invite (Para 0040, 0048) which would include survey ID and password information (Para 0065, equivalent to user name and password), and offering incentives to users to participate in the survey system (Para 0029, 0073)
14. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included (d) establishing an Internet based web page containing a survey form; (e) preparing an invitation for each candidate which includes (1) an incentive to respond, and (2) a unique user name and password for accessing the survey form by the Internet; and (g) e-mailing each candidate a unique user name and password for electronically accessing the survey form and a hyperlink to the survey form, as disclosed by Thomas in the system disclosed by Sanoff, for the advantage of providing a method for surveying candidates who may be interested in an educational institution, with ability to increase system effectiveness and efficiency by incorporating Internet technology in the surveying process, thereby increasing the

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automated reach of the system to customers, while decreasing transmission costs (Automation of a manual process: *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)) (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

15. Furthermore, Sanoff and Thomas fail to expressly disclose e-mailing the user from a named individual at an e-mail address that includes the name of the institution.
16. However, Thomas does disclose providing the user with an e-mail invitation to participate in a survey (Para 0048), and Official Notice is taken that e-mail technology was well capable of addressing an e-mail from a multitude of name specific address and addressing the e-mail from a multitude of senders, and it would have been obvious to one of ordinary skill at the time the invention was made to address the survey from the appropriate source to inform the user of legitimate marketing.
17. Furthermore, Sanoff and Thomas both fail to expressly disclose sending an invitation to participate in a survey to a user through a prepared mailing package, including (3) a postage prepaid response card.
18. However, Bayer discloses inviting users to participate in a survey system through e-mail, regular mail or other advertising media (C8 L30-49), and Official Notice is taken that a postage prepaid response card was a well known form of advertising media to one of ordinary skill in the art at the time the invention was made.
19. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included sending an invitation to participate in a

survey to a user through a prepared mailing package, including (3) a postage prepaid response card, as disclosed by Bayer, in the system disclosed by Thomas in the system disclosed by Sanoff, for the advantage of providing a method for surveying candidates who may be interested in an educational institution, with ability to increase system effectiveness, efficiency, and ability to reach a larger population, by sending invitations to potential users through a variety of communication formats (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

20. **Claims 2, 4-6, 9, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanoff et al. (Sanoff, Alvin P.; Glastris, Kukula, The Consulting game: Schools turn to outside help to target and select students.” US News & World Report, v119, n11, p119(4), September 18, 1995) in view of Thomas (US 2002/0002482 A1).**
21. As per **independent Claim 2**, Sanoff discloses a method for surveying those candidates (pg.2, telequalifying) who may be interested in an educational institution comprising the steps of: (a) obtaining a list of candidates who are believed to have an interest in attending an educational institution; (b) developing a database relating to the candidates; (c) using the information in the data base to segment the candidates based on one or more criteria established by the educational institution (Pg.2, developing applicant pool); and (f) evaluating the interest of each candidate completing a survey (Pg.2, determining extent of applicant interest).

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22. Sanoff fails to expressly disclose electronically surveying candidates by (d) establishing an Internet based web page containing a survey form; (e) e-mailing each candidate a unique user name and password for electronically accessing the survey form and a hyperlink to the survey form.
23. However, Thomas discloses a method for surveying customers (potential applicants), which includes establishing a web-based survey, and inviting the customer to take the survey through e-mailing (Para 0048), and providing user password and ID information along with the survey invitation (Para 0065).
24. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included electronically surveying candidates by (d) establishing an Internet based web page containing a survey form; (e) e-mailing each candidate a unique user name and password for electronically accessing the survey form and a hyperlink to the survey form, as disclosed by Thomas in the system disclosed by Sanoff, for the advantage of providing a method for surveying candidates who may be interested in an educational institution, with ability to increase system effectiveness and efficiency by incorporating Internet technology in the surveying process, thereby increasing the automated reach of the system to customers, while decreasing transmission costs (see also automation of a manual process: *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)).
25. Furthermore, Sanoff and Thomas fail to expressly disclose e-mailing the user from a named individual at an e-mail address that includes the name of the institution.
26. However, Thomas does disclose providing the user with an e-mail invitation to participate in a survey (Para 0048), and Official Notice is taken that e-mail

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technology was well capable of addressing an e-mail from a multitude of name specific address and addressing the e-mail from a multitude of senders, and it would have been obvious to one of ordinary skill at the time the invention was made to address the survey from the appropriate source to inform the user of legitimate marketing.

27. As per Claim 4, Sanoff and Thomas disclose wherein the survey form is customized using information from the data base (Sanoff: Targeted Applicant Marketing – would include adjusting provided information based on user profile information).
28. As per Claim 5, Sanoff and Thomas disclose wherein the survey form is customized with graphics as a function preselected candidate information in the data base (Sanoff: Targeted Applicant Marketing – would include adjusting provided information based on user profile information).
29. As per Claim 6, Sanoff and Thomas fail to expressly disclose wherein the information is related to an extracurricular activity.
30. However, Sanoff discloses providing target marketing to Applicant, based on Applicant information (Pg.2) – the type of information would be non-function to the claimed method steps. *See In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
31. As per Claim 9, Sanoff and Thomas disclose wherein the unique identifier is locked out upon completion of the survey to thereby prevent multiple surveys from the same candidate (one-time use programming).

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32. As per Claim 11, Sanoff and Thomas fail to expressly disclose the further step of following up with a second e-mail a predetermined time after the initial e-mail in the absence of a response.
33. However, it would have been obvious to one of ordinary skill in the art to repeat a process such as the survey method steps provided by Sanoff in view of Thomas, if no response was received from an Applicant designated from the Applicant pool to receive the initial communication, as a way to improve the chances of recruiting applicants.
34. As per Claim 12, Sanoff and *Thomas* disclose including the real time monitoring of the web site; the step of updating a separate reporting web site indicative of cumulative activity of all candidates; and wherein the reporting web site includes the number of candidates responding to each question on the survey (Fig.2, Active survey response database and networked survey manager – would include equivalent information and display techniques).

Response to Arguments

35. Applicant's arguments filed 1/4/2008, with respect to Claims 1, 2, 4-6, 9, 11, 12, and 16, have been considered but are not persuasive. The rejection will remain as FINAL, based on the cited prior art.
36. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period,

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then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

37. As per Independent Claims 1 and 16, the Applicant has made the argument that the cited prior art fails to teach or disclose providing an incentive for responding to a survey.

38. However, Thomas disclose offering incentives to users to *participate (become registered participants)* in the survey system (Para 0029, 0073); wherein participation in the system disclosed by Thomas would obviously include registering and completing surveys – if not, the prior art would just offer incentives for registering not to become registering “participants.”

39. As per independent Claims 2, the Applicant has made the argument that the cited prior art fails to teach or suggest providing (e-mailing) the user with a hyperlink to the survey form.

40. However, Thomas discloses a method for surveying customers (potential applicants), which includes establishing a web-based survey, and inviting the customer to take the survey through e-mailing (Para 0048), and providing user password and ID information along with the survey invitation (Para 0065).

41. Furthermore, inviting a user to participate in a web-based survey would have had to include a web-site to find the web-based survey system, and by typing the web-site into the e-mail, word-processing software at the time the invention was made would automatically create a hyperlink through the inputted/typed website address.

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42. Finally, the Applicants arguments regarding the dependent claims are addressed in the clarified rejection above.

Conclusion

43. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
44. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.
45. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

April 15, 2008

/Jonathan Ouellette/

Primary Examiner, Art Unit 3629